

Remarks

The Examiner is reminded that the Applicant has received a number of official actions in this application dealing with the merits of the pending claims without receiving a final rejection. Note the official action dated September 26, 2002, the official action dated May 28, 2003 which was replaced with an official action dated June 18, 2003, an official action dated January 14, 2004 and now this official action dated July 29, 2004.

If the Examiner is not prepared to allow the claims in this application, then the Applicant respectfully requests that the Examiner issue a final rejection so that this matter can be taken to the Board of Appeals. It is unfair to the Applicant to continue to issue official actions which have contained and currently contain improper prior art rejections.

Turning now to the present official action, the Examiner starts off with a double-patenting objection under 37 CFR 1.75. The Examiner directs the Applicant's attention to MPEP 706.03(k). With all due respect to the Examiner, it appears that the Examiner has not read the MPEP section to which he directs Applicant. Enclosed herewith is a copy of the MPEP section in question. The Examiner is respectfully requested to read the last sentence of the first paragraph thereof which tells the Examiner that "a mere difference in the scope between claims has been held to be enough" to avoid a double-patenting or duplicate claiming objection. If the Examiner compares the claims, the Examiner will note that they are not identical and that they include significantly more than "a mere difference in scope" therebetween, and therefore the objection is not well taken.

The Examiner rejects claims 1, 3-6, 8-9, 19-20, 23-26 and 28-30 under 35 U.S.C. 102 as allegedly being anticipated by US Patent No. 5,781,327 to Brock. This grounds for rejection is respectfully traversed. With respect to the '327 patent, the Examiner characterizes element 12, shown in Figure 1 thereof as being "a laser." With all due respect to the Examiner, where is there any teaching in the '327 patent that element 12 shown in Figure 1 is a "laser" as asserted by the Examiner in the official action?

The '327 patent characterizes element 12 as being a "optical amplifying medium." Of course, lasers have optical amplifying mediums. But, they have more than just that. It is believed that people in the art know that lasers oscillate. Oscillators tend to have amplifiers and therefore it should not be too surprising that one of the elements which makes up a laser is indeed some sort of amplifying medium.

Enclosed herewith is a copy of a paper found on the Internet that apparently relates to a course taught at a university or other school about the basics of a laser. Note that it is entitled "Three Key Elements in a Laser." The amplifying medium is but one element of a laser.

Now, it might be that some skilled in the art might refer to the entirety of what is shown in Figure 1 as being a "laser" since once you connect up the optical amplifying medium in an optical feedback path, as shown, it might well oscillate. However, if the entirety of that which is shown in Figure 1 is a ring laser, for example, then its "carrier suppressed output" which occurs at the output of the ring laser is hardly "a single frequency laser having a laser output for delivering laser light at a frequency  $\omega_0$ " as specifically claimed by claim 1!

With respect to the propriety of referring to the entirety of that which is shown in Figure 1 as being a "ring laser", please see column 4, lines 51-56 of the '327 patent.

If the Examiner is going to continue to contend that a mere optical amplifying medium 12 as shown in Figure 1 comprises a laser, then the Examiner is obviously reaching outside the disclosure of the '327 patent and must be relying upon alleged "facts" within the Examiner's own knowledge. As such, the Examiner is respectfully requested, in that event, to produce the Affidavit required by the Rules of Practice indicating why a mere amplifying medium comprises a laser. See 37 CFR 1.104(d)(2).

Turning to the other assertions made by the Examiner in the official action, the Examiner asserts that the residual sideband filter 14 shown in Figure 1 of the '327 patent

meets the limitation "a filter coupled to an output of the modulator for suppressing and/or passing one of the two sidebands." Filter 14 is not for "suppressing or passing one of the two sidebands" as specifically recited in claim 1. Moreover, note claim 9, which the Examiner also rejected. Claim 9 also recites that the "filter suppresses any carrier produced by the modulator." Filter 14 in the '327 patent does just the opposite! It is a narrow band filter that removes the residual sidebands. See column 4, lines 13-15 of the '327 patent. Note also claim 6 that recites that the filter "suppresses one of the two sidebands and leaves the other sideband substantially unattenuated." The Examiner asserts in the official action that claim 6 is anticipated by the '327 patent. How can that be in view of the specific disclosure in the reference to the contrary?

Turning now to some of the other rejections in the official action, the Examiner rejects claims 2, 7, 21-22 and 31-34 under 35 U.S.C. 103 as allegedly being obvious over the '327 patent in view of US Patent No. 5,777,778 to Yao. Of course, this grounds for rejection is also traversed. Since these claims include, by reference all of the limitations of claim 1 and any intervening claims, the '327 patent is irrelevant for the reasons already noted. The citation of '778 does not help the Examiner. Indeed, the Applicant has argued that patent alone in the past. Now the Examiner asserts, with respect to claims 2 and 22, that it would somehow be obvious to use Yao's optical coupler in the embodiment of Figure 1 of the '327 patent. The '778 patent shows an optical coupler at element 604, for example, in Figure 6a thereof. Since the Examiner did not identify, with particularity, the exact coupler that he is referring to in the official action, it is hard to know which coupler he has in mind when referring to Yao. But, whatever coupler it might be, why would a person of ordinary skill in the art who was familiar with these two references be motivated to stuff an optical coupler into Figure 1 of the '327 patent? Note that the apparatus shown in Figure 1 of the '327 patent already has an output. See the carrier suppressed output at the output of element 10. So, it would not seem that someone would be using an optical coupler in order to provide an output since Figure 1 of '327 already has an output. Moreover, claim 2 recites that "the modulator is coupled to the laser via an optical coupler whereby the modulator receives a portion of a laser's output." Of course, this brings us back to the issue that element 12 is not a laser. But, ignoring that problem for the moment, why would anyone put an optical coupler

between the optical amplifying medium 12 and the modulator 10 since that would just cause light to leak out at the point? If the entirety of that which is shown in Figure 1 oscillates, then it seems that the loop gain must be more than one. Why put in an element that would reduce the loop gain? What is the motivation for doing this? It is noted that the official action is silent with respect to any plausible motivation for making the change suggested by the Examiner and therefore it is submitted that the motivation is coming from Applicant's own disclosure as opposed to from the prior art. The Examiner is improperly using Applicant's own disclosure against Applicant.

Reconsideration of the application as amended is respectfully requested.

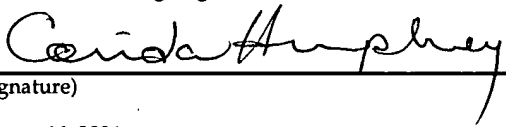
The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 12-0415. In particular, if this response is not timely filed, then the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136 (a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 12-0415.

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Respectfully submitted,



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**706.03(k) Duplicate Claims**

Inasmuch as a patent is supposed to be limited to only one invention or, at most, several closely related indivisible inventions, limiting an application to a single claim, or a single claim to each of the related inventions might appear to be logical as well as convenient. However, court decisions have confirmed applicant's right to restate (i.e., by plural claiming) the invention in a reasonable number of ways. Indeed, a mere difference in scope between claims has been held to be enough.

Nevertheless, when two claims in an application are duplicates, or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other claim under 37 CFR 1.75 as being a substantial duplicate of the allowed claim.

Form paragraphs 7.05.05 and 7.05.06 may be used where duplicate claims are present in an application.

**¶ 7.05.05 Duplicate Claims, Warning**

Applicant is advised that should claim [1] be found allowable, claim [2] will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

**Examiner Note:**

1. Use this form paragraph whenever two claims are found to be substantial duplicates, but they are not allowable. This will give the applicant an opportunity to correct the problem and avoid a later objection.

2. If the claims are allowable, use form paragraph 7.05.06.

**¶ 7.05.06 Duplicate Claims, Objection**

Claim [1] objected under 37 CFR 1.75 as being a substantial duplicate of claim [2]. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

**Examiner Note:**

If the duplicate claims are not allowable, use form paragraph 7.05.05.

See MPEP § 804 for double patenting rejections of inventions not patentable over each other.

**706.03(m) Nonelected Inventions**

See MPEP § 821 to § 821.03 for treatment of claims held to be drawn to nonelected inventions.

**706.03(o) New Matter****35 U.S.C. 132. Notice of rejection; reexamination.**

(a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

In amended cases, subject matter not disclosed in the original application is sometimes added and a claim directed thereto. Such a claim is rejected on the ground that it recites elements without support in the original disclosure under 35 U.S.C. 112, first paragraph, *Waldemar Link, GmbH & Co. v. Osteonics Corp.* 32 F.3d 556, 559, 31 USPQ2d 1855, 1857 (Fed. Cir. 1994); *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981). See MPEP § 2163.06, § 2163.07(b) for a discussion of the relationship of new matter to 35 U.S.C. 112, first paragraph. New matter includes not only the addition of wholly unsupported subject matter, but may also include adding specific percentages or compounds after a broader original disclosure, or even the omission of a step from a method. See MPEP § 608.04 to § 608.04(c). See *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976) and MPEP § 2163.05 for guidance in determining whether the addition of specific percentages or compounds after a broader original disclosure constitutes new matter.

In the examination of an application following amendment thereof, the examiner must be on the alert to detect new matter. 35 U.S.C. 132 should be employed as a basis for objection to amendments to the abstract, specification, or drawings attempting to add new disclosure to that originally disclosed on filing.

If subject matter capable of illustration is originally claimed and it is not shown in the drawing, the claim

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